

## **REMARKS**

This is a full and timely response to the outstanding final Office Action mailed November 22, 2004. Reconsideration and allowance of the application and pending claims are respectfully requested.

### **I. Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1, 4, 7-9, 12, 14, and 18-24 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Morcos, et al. ("Morcos," U.S. Pat. No. 6,384,849). Applicant respectfully traverses this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the claimed invention is represented in the Morcos reference. Applicant discusses Applicant's claims and the Morcos reference in the following.

#### **A. Claims 1, 4, 7, 8, and 18-20**

Independent claim 1 provides as follows (emphasis added):

1. A method of providing a menu in relation to a document, the method comprising:

*creating a document within a program;*

identifying a predetermined behavior that can be used to modify documents opened within the program but that is not generally available for selection from a main menu of the program;

*specifically associating the predetermined behavior with the created document*; and

*creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened within the program* but that is not made generally available for all documents opened within the program, such that the predetermined behavior will be available for selection from the main menu for the created document but not necessarily for other documents opened within the program.

As is acknowledged in the Office Action, Morcos describes merging menu items into a main menu of a first program (e.g., MS Word™) when a file from another program (e.g., MS Excel™) is embedded and displayed in a document (e.g., Word™ document) that is created in the first program.

Applicant distinguishes the Morcos process from what is recited in Applicant's claim 1. As is noted above, claim 1 requires "creating a document within a program", "specifically associating the predetermined behavior with the created document", and "creating a menu item associated with the predetermined behavior that is configured for addition to the main menu of the program when the created document is opened within the program". Morcos fails to disclose several aspects of those limitations. First, because Morcos describes embedding a file from one program into a document of a second program, Morcos fails to teach or suggest creating a menu item for addition to a main menu of a given program when a document *that was created in that same program* is opened within the program. In other words, Morcos, at best, discloses adding a menu item when documents from a different program are imported.

As a further point, Applicant notes that Morcos does not disclose that the merged menu items are added to the main menu “when the created document is opened within the program.” To the contrary, Morcos only describes such merger when a document is embedded into another. Morcos, column 13, lines 25-33.

Finally, Applicant notes that Morcos says nothing about “specifically associating the predetermined behavior with the created document”. Although Morcos describes merging menu items when a file from one program is embedded into a document of another type, Morcos neither teaches or suggests that an association is created between the menu items and the *document* at issue. Without such a teaching, Morcos cannot anticipate Applicant’s claims.

#### **B. Claims 9 and 21-23**

Independent claim 9 provides as follows (emphasis added):

9. A system for displaying a menu on a display device in relation to a particular document, the system being stored on a computer-readable medium, the system comprising:

logic configured to *create a particular document within a program*;

logic configured to *specifically associate a predetermined behavior with the particular document*;

logic configured to create a menu fragment associated with the predetermined behavior, the menu fragment being configured for addition to a main menu of the program; and

logic configured to *merge the menu fragment with the main menu when the particular document is opened* such that the predetermined behavior is made available for selection from the main

menu of the program for the particular document but not necessarily for other documents opened within the program.

Morcos fails to teach or suggest each of “logic configured to create a particular document within a program”, “logic configured to specifically associate a predetermined behavior with the particular document”, and “logic configured to merge the menu fragment with the main menu when the particular document is opened”, for at least the same reasons described above in relation to the discussion of claim 1. Applicant refers the Examiner back to that discussion.

#### **C. Claims 12 and 14**

Independent claim 12 provides as follows (emphasis added):

12. A method of providing a menu in relation to a particular *document that was created with and is running in a program*, the method comprising:

receiving a user input;

generating a command message in response to the user input, the command message comprising a command ID indicative of a predetermined process that corresponds to a selected menu item;

determining if the command ID corresponds to a predetermined behavior that has been specifically associated with the particular document; and

initiating a process represented by the predetermined behavior *where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document.*

As a first matter, Morcos fails to teach or suggest “initiating a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document”, for reasons described in the foregoing. Again, Morcos does not describe specifically associating predetermined behaviors with documents.

As a further point, Applicant notes that Morcos does not teach or suggest performing the various recited actions in relation to a document that was “created with an is running in a program”. Again, Morcos only describes menu item merger in relation to documents from one program that are embedded into documents of another program.

**D. Claim 24**

Independent claim 24 provides as follows (emphasis added):

24. A system stored on a computer-readable medium, the system comprising:

logic configured to receive a user selection of a menu item;

logic configured to generate a command message in response to the user selection, the command message comprising a command ID indicative of a predetermined process that corresponds to the selected menu item;

logic configured to determine if the command ID corresponds to a predetermined behavior that has been specifically associated with a particular document; and

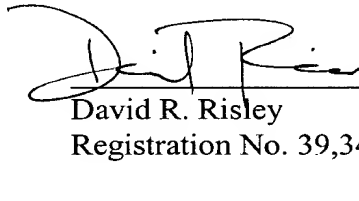
logic configured to initiate a process represented by the predetermined behavior *where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document.*

Regarding claim 24, Morcos does not teach or suggest “logic configured to initiate a process represented by the predetermined behavior where it is determined that the command ID corresponds to the predetermined behavior that has been specifically associated with the particular document”, at least for reasons described in relation to claim 12.

### CONCLUSION

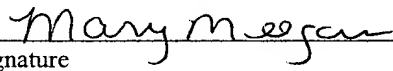
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

  
David R. Risley  
Registration No. 39,345

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

12-27-04

  
Signature